U.S. DISTRICT COURT
DISTRICT OF NEVADA
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UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEVADA

BLAKE A. FIELD, Plaintiff, vs. GOOGLE, INC., a corporation Defendant.	Case No. CV-S-04-0413-RCJ-GWF **PLAINTIFF'S REPLY TO GOOGLE'S OPPOSITION TO PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT**
AND RELATED COUNTERCLAIMS	

COMES NOW Plaintiff, Blake A. Field, who hereby submits his Reply to Google's Opposition to Plaintiff's Motion for Summary Judgment.

A. PLAINTIFF'S PRIMA FACIE CASE

Google musters no argument regarding the ownership or copyrightability of the 51 works at issue in this litigation – thus conceding that Plaintiff is the sole owner of the 51 registered copyrighted works. As pointed out in Plaintiff's Motion, all that need be shown for Plaintiff's prima facie case is ownership of the copyrights and infringement upon Plaintiff's exclusive rights – here, the reproduction and distribution of Plaintiff's works. Having conceded the ownership issue, Google's Opposition focuses on the infringing activity aspect of the prima facie case.

Google states that Plaintiff cannot establish a prima facie case of infringement against Google "based upon Google's having made available 'Cached' links to pages from [Plaintiff's] site." This statement grossly misstate's Plaintiff's case against Google: Indeed, Plaintiff is not seeking redress merely for Google having made available links to its cache of Plaintiff's works, but rather for the reproduction and distribution of those works themselves. Although discussed in Plaintiff's

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Opposition to Google's Motion for Summary Judgment, it is appropriate to incorporate Plaintiff's arguments again here as it may well be that Google's Motion for Summary Judgment is not properly before the Court.

To support its argument against a finding of direct infringement, Google cites to wholly inapplicable law. First, Google cites to UMG Recordings, Inc. v. Hummer Winblad Venture Ptnrs. (In re Napster, Inc.), 377 F. Supp. 2d 796 (D. Cal. 2005). Those portions of this opinion cited by Google relate to a claim by the plaintiffs that the Napster music file sharing service, merely by maintaining an index of available files to download, directly infringed the plaintiffs' copyrights without more. Id. at 803. The Court rejected this theory of liability, stating:

> Napster did not have works in its "collection"; it did not have a "collection" of recordings. The infringing works never resided on the Napster system. Instead, plaintiffs here seek to establish copyright infringement based on the mere fact that the names of their copyrighted musical compositions and sound recordings appeared in Napster's index of available files. This might constitute evidence that the listed works were available to Napster users, but it is certainly not conclusive proof that the songs identified in the index were actually uploaded onto the network..
>
> Rather than requiring proof of the actual dissemination of a copyrighted work or an offer to distribute that work for the purpose of its further distribution or public performance, plaintiffs' theory is premised on the assumption that any offer to distribute a copyrighted work violates section 106(3). This is not sufficient to satisfy plaintiffs' burden of proving that Napster or its users directly infringed their copyrighted musical compositions and sound recordings, as they must do if they are to hold defendants secondarily liable for that infringement.

Id. at 803, 805. Thus, the court in In re: Napster, Inc. merely rejected the plaintiffs' argument that by simply maintaining an index of potentially infringing files, Napster infringed plaintiffs' copyrights.

Here, the functionality of the Google cache is very different from that in Napster. First, Google's webcrawling robot, the Googlebot, copies each and every webpage it visits back to Google servers. See Decl. Brougher at ¶ 4-5. Unless a webpage contains a meta-tag instructing to the contrary, the copy of that webpage remains on Google's servers as the Google cache of that webpage. See Decl. Brougher at ¶ 19. A link to the Google cache copy of the webpage is included in pertinent Google search results and may be accessed directly. See Decl. Brougher at ¶ 7. When an internet user clicks that link or directs his or her browser to the URL of that link, Google reproduces its cache copy of that webpage and distributes it to the requesting user. See Decl. Brougher at ¶ 8.

Hence, here it is Google itself that gathered the copyrighted materials, Google itself which stores the material on its own servers, and Google itself which reproduces and distributes those materials at the request of its customers. That Google responds automatically to a request of its customer to do so is of no import. By reproducing and distributing the materials at the request of its customers, Google itself directly infringes Plaintiff's copyrights. See Playboy Enters. v. Webbworld Inc., 991 F. Supp. 543 (D. Tex. 1997)

Google's cited case of Sega Enters. v. MAPHIA, 948 F. Supp. 923 (D. Cal. 1996) does not support its notion that it cannot be held directly liable for copyright infringement. In Sega, defendant operated a file-sharing service to which users could dial-in and connect by modem. Once connected, users could upload Sega videogames onto defendant's service, and download therefrom as well. Id. at 927. After finding that uploading and downloading illustrated copying by *someone*, the Sega court stated:

> This does not end the inquiry, however, because it does not establish whether Sherman, as the BBS operator, is directly liable for the copying. In Netcom, the court found that the Internet provider was not directly liable for copyright infringement of a copyrighted work posted and distributed through its system. Netcom, 907 F. Supp. at 1368-70. The Netcom court held that "although copyright is a strict liability statute, there should be some element of volition or causation which is lacking where a defendant's system is merely used to create a copy by a third party." Id. at 1370. "Where the infringing subscriber is clearly directly liable for the same act, it does not make sense to adopt a rule that could lead to the liability of countless parties whose role in the infringement is nothing more that setting up and operating a system that is necessary for functioning of the Internet," even where the Internet provider has knowledge of potential copyright infringement by its subscribers. Id. at 1372-73.
>
> While Sherman's actions in this case are more participatory than those of the defendants in Netcom, the Court finds Netcom persuasive. Sega has not shown that Sherman himself uploaded or downloaded the files, or directly caused such uploading or downloading to occur. The most Sega has shown is that Sherman operated his BBS, that he knew infringing activity was occurring, and that he solicited others to upload games. However, whether Sherman knew his BBS users were infringing on Sega's copyright, or encouraged them to do so, has no bearing on whether Sherman directly caused the copying to occur. Id. at 1372. Furthermore, Sherman's actions as a BBS operator and copier seller are more appropriately analyzed under contributory or vicarious liability theories. Therefore, because Sega has not shown that Sherman directly caused the copying, Sherman cannot be liable for direct infringement.

Sega Enters. v. MAPHIA, 948 F. Supp. 923, 932 (D. Cal. 1996) (quoting in part Religious Technology Center v. Netcom On-line Communication Services, Inc., 907 F. Supp. 1361 (N.D. Cal. 1995)). Hence, because defendant in Sega did not directly cause the copying to occur, there was no liability for direct copyright infringement.

Those factors mentioned by the Sega court as establishing direct infringement are present here. Again, it is Google which copies material to its own servers – in other words, Google uploads this material to its own servers. See Decl. Brougher at ¶ 4-5. It is Google itself which makes its cache copies of webpages available. And it is Google itself which responds to its customer's requests by reproducing and distributing to those requesting users webpages from its cache. No more compelling case could be made for direct copyright infringement. Thus, Google's erroneous notion that it is not directly liable for copyright infringement should be rejected.

B. Plaintiff owed to Google no duty to speak. Therefore, Google's estoppel defense fails as a matter of law.

This argument was well-mapped in Plaintiff's Opposition to Google's Motion for Summary Judgment. However, as there remains some doubt as to whether Google's Motion is properly before the Court, that argument is again incorporated herein.

Google's affirmative defense of estoppel is predicated on Plaintiff's silence. Per Google, Plaintiff's failure to speak up and inform Google that Plaintiff did not want his webpages reproduced and distributed by Google misled Google into including those webpages in its cache, and reproducing and distributing those webpages therefrom. The law is well settled that, when an estoppel is asserted as arising from another's silence, the person maintaining such silence must have been under a duty to speak before estoppel will lie. Wisler v. Lawler, 189 U.S. 260, 270 (U.S. 1903), James v. Nelson, 90 F.2d 910, 917-918 (9th Cir. 1937) (quoting Nelson v. Chicago Mill & Lumber Corporation, 76 F.2d 17, 21 (8th Cir. 1935). See also Simpson Timber Co. v. Palmberg Constr. Co., 377 F.2d 380, 385 (9th Cir. 1967) (same under fraud analysis). At no turn does Google allege or even argue that Plaintiff owed to Google a duty to speak. Lacking this critical element, Google's equitable estoppel defense fails.

Those cases cited by Google in support of its argument that silence alone relate to arguments of acquiescence – not estoppel. One such case is Quinn v. City of Detroit, 23 F. Supp. 2d 741, 753 (D. Mich. 1998). In Quinn, Mr. Quinn, an attorney for the City of Detroit, developed a litigation management software program referred to as LMS. This development was done outside the scope of his usual work duties. After creating LMS, he uploaded it to the City of Detroit's legal department computers sometime in 1992. Soon thereafter, everyone in the legal department began using LMS to perform litigation management functions. This widespread use throughout the department continued with Quinn's knowledge for *more than three years*. Finally, upset about attempted changes to the software, and the legal department's assertion of proprietary rights in LMS, on November 20, 1995, Quinn scribed a letter to the department head. Therein, Quinn withdrew his permission for the City's use of LMS and instructed all software copies be removed from the City's computers. The City responded, asserting its rights to the LMS software and forbidding Quinn from authoring further changes to it. After registering copyright to the LMS software, Quinn brought suit for infringement the following year. Id. at 743-744.

After setting forth four equitable estoppel factors pursuant to Hampton v. Paramount Pictures Corp., 279 F.2d 100 (9th Cir. 1960), the Quinn court then compressed the separate – but related – equitable defense of acquiescence to fall within the ambit of estoppel: "'The plaintiff's acquiescence in the defendant's infringing acts may, if continued for a sufficient period of time and if manifested by overt acts result in an abandonment of copyright.' In such a case, the estoppel 'destroys the right asserted' and will be a defense for all acts occurring after the acquiescence. Id." Quinn, 23 F. Supp. 2d at 753 (quoting in part 1 M. Nimmer & D. Nimmer, Copyright §§ 13.07 (1990)). That said, the Quinn court found that, given Quinn's knowledge of the City's use of his LMS software for a period of at more than 3 years, during which time he never complained, Quinn acquiesced to the City's use of the LMS software and thus could not assert claims for infringement against the City. Id. Hence, the issue of plaintiff's silence in Quinn focused on silence throughout a years-long period of known use, thus leading to a finding of acquiescence.

The cases of Carson v. Dynegy, Inc. 344 F.3d 446 (5th Cir. 2003) and Keane Dealer Servs. v. Harts, 968 F. Supp. 944 (D.N.Y. 1997) are further cited by Google in support of its argument that Plaintiff induced Google to infringe by his silence. Both of these cases track the fact pattern of Quinn closely in that they involved former employees who provided software to a company, allowed the company to utilize the software for significant periods of time without complaint or notice, and then filed suit. See Carson, 344 F.3d at 448-451; Keane, 968 F. Supp. at 945-947.

The Federal Circuit succinctly stated the relationship between silence relative to a duty to speak, and that relative to a known acquiescence: "[S]ilence alone will not create an estoppel unless there was a clear duty to speak, (see Reay v. Raynor, 19 F. 308, 311 (C.C.S.D.N.Y. 1884)), or somehow the patentee's continued silence reenforces the defendant's inference from the plaintiff's known acquiescence that the defendant will be unmolested." A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1043-1044 (Fed. Cir. 1992).

Those holdings of Quinn, Carson, and Keane cited by Google to support the notion that silence alone will support a finding of estoppel relate only to known acquiescence and are wholly inapplicable to this matter. Moreover, the facts at issue in this matter are very much distinguishable from those at play in the referenced cases. Here, Google does not allege that it had utilized Plaintiff's works for any period of time without complaint from Plaintiff – silence of the type referenced to and relied upon in those cases. Google does not argue that Plaintiff remained silent for a period of time while Google used his works, thus creating a known acquiesence. Rather, Google asserts that it relied on Plaintiff's silence in failing to prevent Google from using Plaintiff's works from the get-go. It is this type of silence relied upon by Google which requires a duty to speak. The existence of such duty has never been averred or even argued by Google. Thus, because (1) Google's equitable estoppel defense is founded upon Plaintiff's silence, and (2) silence does not create an estoppel absent a duty to speak, and (3) Google fails to allege or even argue that Plaintiff had a duty to speak, Google's equitable estoppel defense/counterclaim fails as a matter of law.

C. GOOGLE'S IMPLIED LICENSE ARGUMENT FAILS AS A MATTER OF LAW

As with other arguments above, although addressed in Opposition to Google's Motion for Summary Judgment, these arguments must necessarily be restated as there remains doubt as to whether Google's Motion is before the Court.

Citing to the same cases and providing the same arguments as it does for its equitable estoppel defense, Google attempts to discern a distinct argument for implied license. Google's reliance on these cases is misplaced. The Ninth Circuit has succinctly held that, under copyright law, whether an implied license has been created is a matter of state contract law interpretation. Foad Consulting Group, Inc. v. Musil Govan Azzalino, 270 F.3d 821, 827 (9th Cir. 2001). Critically, at no turns does Google cite to any state law – California or Nevada – to support its implied license argument. Thus, Google's implied license claim – which, regardless, is indistinct from its equitable estoppel claim – fails because there is absolutely no law cited to support such a claim.

Even the outmoded law cited by Google fails to support its implied license claim. Google refers to Effects Assocs., Inc. v. Cohen, 908 F.2d 555 (9th Cir. 1990) to support its implied license claim. In Effects Assocs., plaintiff created special effects movie footage at the request of defendant, then delivered that footage to defendant knowing defendant intended to include it in a movie such that it would be reproduced and distributed as movies do. Id. at 555-558. The court focused on these factors and held that where an author has created a copyrighted work at the request of another and delivered that work to that person with knowledge of its putative infringing use (ie reproduction and distribution), the author grants an implied license to that person to utilize the works as per plan. Id. at 558-559.

The similar case of Herbert v. United States, 36 Fed. Cl. 299 (1996) to support its implied license claim. In Herbert, plaintiff created copyrighted works at the request of the defendant, then delivered those works to defendant, with knowledge of the defendant's goal to utilize the works in further publication. Id. at 302. Applying the same rationale as Effects Assoc., the court found that because the plaintiff created works at the request of the defendant and delivered them to defendant with knowledge of their putative use, an implied license for that use was granted to defendant. Id. at 310.

Thus, those outmoded cases cited by Google in support of its implied license argument stand only for the notion that where a putative infringer commissions the creation of copyrighted works, and the author delivers those works to the putative infringer with knowledge of that person's intended use, an implied license is granted for that use.

Critically, at no turn does Google argue that it requested of Plaintiff to create the works at issue in this case. For that reason alone, Google's implied license claim fails, as it is a necessary predicate to a finding of implied licenses under Effects Assoc. and its progeny. Further, at no turn did Plaintiff ever deliver to Google any copies of his copyrighted works. Google baldly asserts, without citation to competent evidence whatsoever: "[Plaintiff] manually submitted his site to Google, instructing the Googlebot to find and list the pages of his site in Google's search results." Per Google, this is tantamount to delivery of Plaintiff's works to Google. Tellingly, Google has set forth no evidence that Google knew of Plaintiff submitting his site for possible review by Google. Assuming for the sake of argument that such act could be construed as an attempt to deliver the works, there nevertheless would be no effected delivery as Google was unaware of any such site submissions until Plaintiff's deposition. No competent evidence goes to show otherwise. Quite simply, one may not have something delivered to him or her if he or she is unaware of its arrival.

It has been shown that Google's implied license argument is not supported by state law references as required by Foad, supra. Further, even applying the outmoded law cited by Google, it is clear that no implied license to use Plaintiff's works was ever granted to Google. Thus, Google's implied license defense / counterclaim is void as a matter of law and summary judgment is appropriate thereon.

D. GOOGLE'S SYSTEM CACHING SAFE HARBOR DEFENSE REMAINS UNSUPPORTED

As argued in Plaintiff's Motion, Google's cache does not qualify for the system caching safe harbor of the Digital Millennium Copyright Act, 17 U.S.C. § 512(b). That section provides:

b) System caching.

(1) Limitation on liability. A service provider shall not be liable for monetary relief, or, except as provided in subsection (j), for injunctive or other equitable relief, for infringement of copyright **by reason of the intermediate and temporary storage of material on a system or network** controlled or operated by or for the service provider in a case in which–

(A) the material is made available online by a person other than the service provider;

(B) the material is transmitted from the person described in subparagraph (A) through the system or network to a person other than the person described in subparagraph (A) at the direction of that other person; and

(C) the storage is carried out through an automatic technical process for the purpose of making the material available to users of the system or network who, after the material is transmitted as described in subparagraph (B), request access to the material from the person described in subparagraph (A),

if the conditions set forth in paragraph (2) are met. ...

(Emphasis added). Per section (1) above, only <u>the intermediate and temporary</u> storage of material may qualify for the safe harbor. As made clear in Plaintiff's Motion, material is not added to Google's cache as a result of it serving as an intermediary between the originating website and the ultimate user. <u>See</u> Motion at pp. 16, lines 4-7. Google does not refute this fact in its Opposition. Rather, it argues that it need not serve as an intermediary for the safe harbor to apply. <u>See</u> Opposition at pp. 11, line 15.

Google's position that it need not serve as an intermediary between the originating site and the ultimate user for the safe harbor to apply is contrary to the plain language of the statute. Moreover, the Senate Judiciary Committee's report on this section leaves no doubt that one must be serving in an intermediary capacity in order to take advantage of the safe harbor:

In terminology describing current technology, this storage is a form of ``caching," which is used on some networks to increase network performance and to reduce network congestion generally, as well as to reduce congestion and delays to popular sites. **This storage is intermediate in the sense that the service provider serves as an intermediary between the originating site and ultimate user**. The material in question is stored on the service provider's system or network for some period of time to facilitate access by

> users subsequent to the one who previously sought access to it.

(Emphasis added), See Report of the Committee of the Judiciary, The Digital Millennium Copyright Act of 1998, SR 105-190. It simply could not be clearer that the system caching safe harbor applies only to situations in which storage in the cache is effectuated by an intermediary between the originating site and the ultimate user. The undisputed fact that Google does not serve as an intermediary between the originating site and the ultimate user is fatal to Google's attempted use of the system caching safe harbor.

As has been shown above, the fact that Google does not serve as an intermediary between the originating site and the ultimate user is fatal to its attempted system caching defense. Also fatal to Google's attempted application of the system caching safe harbor is the fact that the Google cache copies of original web pages are not distributed to those requesting access from the original site. As is made clear by the statute, in order for the safe harbor to apply, material stored in the Google cache would have to be distributed as a result of users requesting access to the originating site:

> (C) the storage is carried out through an automatic technical process for the purpose of making the material available to users of the system or network who, after the material is transmitted as described in subparagraph (B), request access to the material from the person described in subparagraph (A) **[originating site]**, if the conditions set forth in paragraph (2) are met.

17 U.S.C. § 512(b)(1)(C). Here, Google admits that its cache copies of webpages are never distributed as a result of users requesting the originating page. Contrary to the plain language of the statute, Google's position is that making available any copy of a webpage, transmitted under any circumstance, is appropriate: "Thus, when users request access to pages directly from a site and are unable to obtain them for whatever reason, the pages are still available to them through Google's cache. Section 512(b) requires no more." See Opposition at pp. 12, lines 6-8. Quite the contrary, actually. The plain language of the statute requires that, in order to fall within the safe harbor, the cached material may be distributed ONLY to those requesting the originating site – not seeking the site's contents from elsewhere – this is the "request access to the material from

the person described in subparagraph (A) [originating site] language of the statute.

As shown in Plaintiff's Motion, and again above, Google's cache does not qualify for the system caching safe harbor. Thus, Plaintiff is entitled to a judgment as a matter of law on this issue.

E. GOOGLE'S UNRAISED AFFIRMATIVE DEFENSES ARE WAIVED

"[A]n affirmative defense must be raised in response to a summary judgment motion, or it is waived." Diversey Lever, Inc. v. Ecolab, Inc., 91 F.3d 1350, 1353 (Fed. Cir. 1999) (citing United Coal Miners Workers of America 1974 Pension v. Pittston Co., 984 F.2d. 469, 478 (D.C. Cir. 1993)). Hence, those affirmative defense unraised by Google in its Opposition have been waived. A review of the Opposition reveals only that fair use, implied license, equitable estoppel, and the system caching (DMCA 512(b)) affirmative defenses are addressed. Other affirmative defenses, including those of DMCA 512(a), (c), and (d), are left unaddressed, despite these properly being affirmative defenses. See Hendrickson v. Amazon.com, Inc., 298 F. Supp.2d 914, 916 (D. Cal. 2003) (confirming that DMCA safe harbors are affirmative defenses). These defenses are waived. Tellingly, in its own Motion for Summary Judgment, Google did not seek judgment on any DMCA safeharbor – lagely because no arguments can be mustered in that regard. Google attempts to justify this obvious waiver of these defenses by footnote in its Opposition to Plaintiff's Motion for Summary Judgment. See Opposition at pp. 10, n. 10. That affirmative defenses not raised either in opposition or in their own motion for summary judgment could be properly addressed by motion to strike or motions in limine is truly ponderous. By failing to argue these points in opposition, and indeed only mustering argument on the system caching (DMCA 512(b)) exception because of Plaintiff's arguments against it in his moving papers, Google has waived these affirmative defenses.

CONCLUSION

For the foregoing reasons, Plaintiff requests that this Court rejects Google's arguments in opposition and grant Plaintiff's Motion for Summary Judgment in its entirety.

Dated this 1st day of November, 2005.

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Reply to to Defendant/Counterclaimant Google, Inc.'s Opposition to Plaintiff's Motion for Summary Judgment was served via US Mail, postage prepaid, upon the following:

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